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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,409	07/03/2003	David J. Good	3023.PKG	4461
7590 01/05/2010				
Cynthia L. Foulke NATIONAL STARCH AND CHEMICAL COMPANY 10 Finderne Avenue Bridgewater, NJ 08807-0500				
EXAMINER				
SCHATZ, CHRISTOPHER T				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
01/05/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,409

Applicant(s)

GOOD ET AL.

Examiner

CHRISTOPHER SCHATZ

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 12, 13, 22 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 12, 13, 22 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

FINAL REJECTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8, 10, 12, 13, 22 and 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Mehaffy et al. (EP 0934990) for the same reasons as presented in paragraph 2 of the Office Action dated 06/09/2009.
3. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehaffy et al. as applied above, and further in view of Baetzold et al. '913 for the same reasons as presented in paragraph 3 of the Office Action dated 06/09/2009.

Response to Arguments

4. Applicant's arguments filed 09/08/2009 have been fully considered but they are not persuasive.

The applicant argues that the examiner's position that because Mehaffy discloses an adhesive with the same composition as the adhesive of the instant application Mehaffy's adhesive meets the limitations of applicant's claims is without merit. This statement is not sufficient to overcome applicant's burden as required by

MPEP 2112 (V). The examiner has provided rational and/or evidence that shows inherency as required by MPEP 2112 (IV). The burden is thus shifted to the applicant to show otherwise. A statement that says the examiner's assertion is without merit is not sufficient to overcome the examiner's rejection. See MPEP 2112 (V).

The applicant argues that Mehaffy fails to teach a delta at or below 100 °F. The applicant is referred to the examiner's discussion of paragraph 0033 of the reference in the previous office actions. The applicant then presents Table A which pulls data from Table I of Mehaffy. The applicant should first note that the samples presented in the Table I of Mehaffy are only exemplary. The applicant is reminded that the disclosure of reference is not limited to the examples and references are good for all they disclose. Even assuming, for the sake of argument, that none of the samples disclosed in Table I of the reference meet the limitations of the instant claims, the reference still discloses the limitations of the claims because other portions of the reference (e.g. paragraph 0033 and the disclosed composition of the adhesive) disclose the claimed adhesive. The applicant's arguments presented on page 7 of the Remarks are applicable only to the composition of the samples discussed in Table I of Mehaffy, not to compositions disclosed in other portions of Mehaffy.

Nonetheless, the applicant has no proof showing that the viscosity will increase about 40% when the temperature decreases 25 °F. The amount the viscosity increases when the temperature decreases is dependent on the composition of the adhesive. The applicant presents no data showing that the samples in Table I will change in the manner asserted by the applicant.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHRISTOPHER SCHATZ** whose telephone number is 571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/
Primary Examiner, Art Unit 1791

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1791